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**OFFICE OF PETITIONS**

In re Application of	:	
Rajeev A. Jain, Jon Swanson,	:	
Robert Hontz, John Devane,	:	
Jenneth Iain Cumming, Maurice	:	
Joseph Anthony Clancy, and	:	
Janet Elizabeth Codd	:	DECISION ON TWO PETITIONS
Application No. 09/337,675	:	UNDER
Filing Date: June 22, 1999	:	37 C.F.R. §§ 1.48 AND 1.183
Attorney Docket Number:	:	
029318/0497	:	
Title: CONTROLLED-RELEASE	:	
NANOPARTICULATE COMPOSITIONS	:	

Background

This is a decision on the two concurrently filed petitions pursuant to 37 C.F.R. §§ 1.48 and 1.183. Petitioner has requested the correction of the inventorship of the present application, along with the waiver of 37 C.F.R. § 1.48(a)(3)<sup>1</sup>.

In short, Petitioner has requested that Gary Liversidge be added as an inventive entity, and that the Office waive the requirement that the applicant provide an oath or declaration by the actual inventors.

With the present submission, Petitioner has submitted the required petition fees, an Application Data Sheet (ADS), a statement by the inventor that is to be added, a declaration that

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<sup>1</sup> Petitioner has requested the waiver of 37 C.F.R. § 1.64, however this is properly treated as a petition to waive 37 C.F.R. § 1.48(a)(3).

has been executed by this individual, and a statement by the assignee consenting to the addition of this individual as an inventive entity.

The ADS that was submitted concurrently with these petitions cannot be accepted. Petitioner will note that an ADS filed with the application is not required to be signed unless the ADS includes a nonpublication request. Rule § 1.33(b) requires that amendments and other papers, except for written assertions pursuant to 37 C.F.R. § 1.27(c)(2)(ii), filed in the application must be signed by an appropriate party. Therefore, an ADS or a supplemental ADS filed after the filing of an application must be signed in accordance with 37 C.F.R. § 1.33(b).

The petition pursuant to 37 C.F.R. § 1.48 is **DISMISSED**.

The petition pursuant to 37 C.F.R. § 1.183 is **DISMISSED**.

A discussion follows.

#### Applicable Rules

37 C.F.R. §1.48(a) sets forth, *in toto*:

(a) Nonprovisional application after oath/declaration filed. If the inventive entity is set forth in error in an executed § 1.63 oath or declaration in a nonprovisional application, and such error arose without any deceptive intention on the part of the person named as an inventor in error or on the part of the person who through error was not named as an inventor, the inventorship of the nonprovisional application may be amended to name only the actual inventor or inventors. Amendment of the inventorship requires:

- (1) A request to correct the inventorship that sets forth the desired inventorship change;
- (2) A statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;
- (3) An oath or declaration by the actual inventor or inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43 or § 1.47;
- (4) The processing fee set forth in § 1.17(i); and
- (5) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).

37 C.F.R. §1.183 sets forth, *in toto*:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may

be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(h).

#### Analysis of the Petition Pursuant to Rule § 1.183

Petitioner has requested the waiver of the requirement that all of the inventors other than the inventor being added to the application must execute the new declaration. As such, Petitioner has requested the waiver of 37 C.F.R. § 1.48(a)(3).

In order to submit a grantable petition pursuant to 37 C.F.R. § 1.183, Petitioner must show (1) that this is an extraordinary situation where (2) justice requires waiver of the rule. In re Sivertz, 227 U.S.P.Q. 255, 256 (Comm'r Pat. 1985).

Petitioner has not established, or even asserted, that either condition exists in this case. The circumstances of this case do not demonstrate an extraordinary situation, much less one where justice requires waiver of the rules.

#### **The existence of an extraordinary situation:**

Petitioner has not set forth that an extraordinary situation exists with this present set of facts. *Assuming arguendo* that Petitioner had made this assertion, Petitioner has requested that the Office waive the requirement that the applicant provide an oath or declaration by the actual inventors, however there does not appear to be anything extraordinary about an Applicant who is faced with the requirement that each of the inventors must execute a declaration.

#### **The question of whether justice requires the waiver of the rule:**

Petitioner has not set forth that justice requires the waiver of 37 C.F.R. § 1.48(a)(3). *Assuming arguendo* that Petitioner had asserted that justice requires the waiver of this rule, it is not understood by the undersigned why justice would require that the Office accept a declaration that has only been executed by one of eight inventors.

#### Analysis of the Petition Pursuant to Rule § 1.48

Petitioner has met requirements (1) - (2) and (4) - (5) of Rule § 1.48. Regarding the third requirement, Petitioner has failed to provide an oath or declaration that has been executed by the

actual inventors, as required by 37 C.F.R. § 1.63, and pursuant to the discussion above, this requirement has not been waived.

### Conclusion

Any reply must be submitted within **TWO MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are permitted. The reply should include a cover letter entitled "Renewed Petition Under 37 C.F.R. §§ 1.48 and 1.183". This is not a final agency action within the meaning of 5 U.S.C § 704.

The renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanowski, and may be submitted by mail<sup>2</sup>, hand-delivery<sup>3</sup>, or facsimile<sup>4</sup>. Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web<sup>5</sup>.

If responding by mail, Petitioner is advised not to place the undersigned's name on the envelope. Only the information that appears in the footnote should be included - adding anything else to the address will delay the delivery of the response to the undersigned.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225<sup>6</sup>. All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.



Paul Shanowski  
Senior Attorney  
Office of Petitions  
United States Patent and Trademark Office

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2 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

3 Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.

4 (571) 273-8300- please note this is a central facsimile number.

5 <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

6 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.